

Application Serial No. 09/782,011

REMARKS

1. Applicant thanks the Examiner for his findings and conclusions.

2. It should be appreciated that Applicant has elected to amend Claim 1, 5, 7, 9, and 12 solely for the purpose of expediting the patent process in a manner consistent with the PTO's Patent Business Goals, 65 Fed. Reg. 54603 (9/8/00). In making such amendments, Applicant has not and does not in any way narrow the scope of protection to which the Applicant considers the invention herein entitled. Rather, Applicant reserves Applicant's right to pursue such protection at a later point in time and merely seeks to pursue protection for the subject matter presented in this submission.

3. Claims 1, 5, 7, 9-12, and 20-28 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1 and 7

Applicant amends Claims 1 and 7 to clarify that Claims 1 and 7 are directed at a computer implemented method and a computer implemented inspector, respectively. The amendments to Claims 1 and 7 tangibly limit the inspector to a physical product. Accordingly, the rejection of Claims 1 and 7 and all claims dependent therefrom under 35 U.S.C. § 101 as being directed to non-statutory subject matter is deemed to be overcome.

Claim 12

As to Claim 12, the Applicant respectfully disagrees. Claim 12 requires a system including computational devices connected by a communications network. This tangibly limits the system to a physical entity. Accordingly, the rejection of Claim

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12 and all claims dependent therefrom under 35 U.S.C. § 101 as being directed to non-statutory subject matter is deemed to be improper.

In order to further clarify the invention, Applicant amends Claim 12 to require the system to be computer implemented thereby still further limiting the system to a physical object. Accordingly, the rejection of Claim 12 and all claims dependent therefrom under 35 U.S.C. § 101 as being directed to non-statutory subject matter is deemed to be overcome.

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- 10 5. Claims 5 and 9 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Applicant amends Claims 5 and 9 to correct typographical errors. Accordingly,
- 15 the rejection under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is deemed to be overcome.

6. The specification is amended at page 1, line 4 to correct the priority claim.

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7. Claims 1, 5, 7, 9-12, and 20-28 stand rejected under a nonstatutory double patenting rejection in view of U.S. patent no. 6,879,979 (hereinafter "Hindawi").

- 25 As to Claims 1, 5, 7, 9-12, and 20-28, Hindawi is directed at the unrelated art of enabling a collection of computers and associated communications infrastructure to offer a new communication process, which allows a requestor to receive configuration information of a computational device from a responder. Claims 1-

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14 of Hindawi do not have claim elements corresponding to claim elements of pending Claims 1, 5, 7, 9-12, and 20-28. Accordingly, the nonstatutory double patenting rejection in view of Hindawi is deemed to be improper.

5 Though Hindawi was cited by the Examiner in the nonstatutory double patenting rejection, the Examiner refers to U.S. patent no. 6,931,434 (hereinafter "Donoho '434") within the body of the nonstatutory double patenting rejection. To further expedite the patent prosecution process, Applicant proceeds with response to this rejection as if the rejection were based upon Donoho '434 with the
10 understanding that the Hindawi patent number was mistakenly applied to Claims 1, 5, 7, 9-12, and 20-28 under a nonstatutory double patenting rejection. Applicant requests clarification from the Examiner on this point.

Applicant hereby submits a timely filed terminal disclaimer to U.S. patent no.
15 6,931,434 in compliance with 37 C.F.R. § 1.321(c). Accordingly, the rejection of Claims 1, 5, 7, 9-12, and 20-28 under a nonstatutory double patenting rejection in view of Donoho '434 is deemed to be overcome.

7. Claims 1, 5, 7, 9-12, and 20-28 stand provisionally rejected under the
20 judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-9 of copending patent application no. 09/997,790 (hereinafter "Donoho '790").

Applicant hereby submits a timely filed terminal disclaimer to copending patent
25 application no. 09/997,790 in compliance with 37 C.F.R. § 1.321(c). Accordingly, the provisional rejection of Claims 1, 5, 7, 9-12, and 20-28 under a nonstatutory double patenting rejection in view of Donoho '790 is deemed to be overcome.

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8. Claims 1, 5, 7, 9-12, and 20-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent no. 6,029,258 (hereinafter "Ahmad").

Claim 1

5 As to Claim 1, Applicant amends Claim 1 to clarify that the inspector automatically evaluates a database of advise for relevance to the consumer's computer by use of an automated advise reader where the advise reader operates in the absence of consumer involvement. Support for the amendment is found in the application as filed at least at page 17, lines 5-11. Applicant
10 certifies that no new matter was added by way of amendment to Claim 1. In view of the current amendment of Claim 1, the rejection of Claim 1 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Ahmad is deemed to be overcome.

Claim 7

15 As to Claim 7, Applicant amends Claim 7 to further define the inspector methods as automatic and unattended inspector methods that view a relevant advisory through a one way membrane without divulging the user's identity. Support for the amendment is found in the application as filed at least at Figure 3 and at
20 page 137, lines 4 and 22-26. Applicant certifies that no new matter was added by way of amendment to Claim 7. In view of the current amendment of Claim 7, the rejection of Claim 7 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Ahmad is deemed to be overcome.

Claim 12

25 As to Claim 12, Applicant amends Claim 12 to place into the claim body from the preamble the requirement of an inspector dispatcher associated with an advice client computer for continually performing relevance determination, where the relevance determination is driven by a database of relevance clauses which can

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be continually evaluated. Applicant further amends Claim 12 to allow the inspector to operate without human intervention. Ahmad teaches the Trouble Shooting System to be user launched at column 1, lines 61-64. In stark contrast to the user launched Trouble Shooting System of Ahmad, the amended Claim 12

5 requires relevance determination without user intervention. Support for the amendment is found in the application as filed at least in original Claim 12 and at page 16, lines 19-20. Applicant certifies that no new matter was added by way of amendment to Claim 12. In view of the current amendment of Claim 12, the rejection of Claim 12 under 35 U.S.C. § 102(e) as being anticipated by Ahmad is

10 deemed to be overcome.

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CONCLUSION

In view of the above, the Application is deemed to be in allowable condition. Applicant therefore earnestly requests the Examiner to withdraw all rejections, permitting the Application to pass to issue as a United States Patent. Should the Examiner have any questions concerning the Application, he is urged to contact Applicant's attorney at (650) 474-8400.

Respectfully submitted,


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